

Attorney's Docket: 1999DE132
Serial No.: 09/722,760
Group: 1756

REMARKS

The Office Action mailed September 21, 2005, has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

Claim Status

Claims 1, 4-10, 17 and 22-24 are pending in this Application. Claims 4, 9, 10 and 17 are withdrawn from consideration. By this Amendment, Applicants have amended claims 1, 6 and 23, while new claim 25 has been added. Claim 5 has been cancelled. In consequence, the claims under consideration are believed to include claims 1, 6-8 and 22-25.

Disclosure

The disclosure stands rejected to because the Office finds that in the amendment to the specification filed on October 1, 2003, page 13, lines 11-15, the symbols representing the chemical bond that is suppose to link the SO_2^- group to the CH group and the chemical bond that is supposed to link the SO_3^- group to the CH group in the chemical moieties are not located in the proper positions. By this Amendment, the subject paragraph has been amended to correct such error.

Claim Rejections Under 35 USC § 112, Second Paragraph

Claim 5 stands rejected under 35 USC § 112, second paragraph, as being indefinite. Specifically, the Office finds two instances within claim 5 where there exists improper Markush language. Claim 5 has been cancelled, and its subject matter imported to amended independent claims 1 and 23. In independent claims 1 and 23, the instances of improper Markush language have been corrected.

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It is thus respectfully contended that the 35 USC § 112, second paragraph rejection has been overcome.

Rejections Under 35 USC § 112, First Paragraph

Claims 1, 7, 8 and 24 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the written description of requirement. Specifically, the Office finds that the specification fails to provide adequate written description for the recitation "low molecular weight, nonpolymeric organic cation." Independent claims 1 and 23 have been amended to recite the subject matter of now cancelled claim 5, which defines a nonpolymeric ammonium ion of the formula (a)-(j).

In view of this amendment, it is respectfully contended that the 35 USC § 112, first paragraph, rejection has been overcome.

Claim Objection

Claim 5 stands rejected to various informalities. As stated above, the subject matter of dependent claim 5 has been added to independent claim 1 and 23. In claims 1 and 23, the informalities referenced by the Office have been corrected.

Claim Rejections Under 35 USC § 103(a)

Claims 1, 5-8, and 22-24 stand rejected under 35 USC § 103(a) as being unpatentable over Japanese Patent 8-6295 (JP'295) combined with US 3,925,278 (Murai), US 4,992,262 (Nakagaki), and US 5,385,776 (Maxfield). The Office cites the THOMAS-DERWENT machine-assisted translation of JP'295 for cites. This rejection is respectfully traversed.

The Office maintains the position that:

JP'295 discloses a charge controlling agent composition that comprises the charge controlling quaternary ammonium salt compound (1) of table 1 of JP'295 and the extender organic bentonite in a weight ratio of 50/50.

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As discussed before in Applicants' previous responses, and is admitted by the Office, the JP'295 reference discloses a charge control agent composition having two main constituents, namely, a charge control agent and a specific extender (paragraph 0014). The charge control agent recited in JP'295 is a quaternary ammonium salt (paragraph 0016). This is the only charge control agent disclosed by JP'295. The extender, as recited in paragraph 00015, includes bentonite.

The Office states on page 10 of the Office Action:

The recitations that the structured silicate salt is added as a charge control agent in claims 1, 5-8, 23 and 24, and that distearyldimethyl ammonium bentonite is added as a charge control agent in claim 22 do not result in a manipulative difference between the method recited in the instant claims and the method rendered obvious over the prior art. Thus, the recitations do not distinguish the method recited in the instant claims from the method rendered over the combined teachings of the prior art. (underlining added)

Applicants respectfully can not agree. There is nothing in the prior art that teaches, suggests, discloses or intimates the method that Applicants are herein claiming, namely, that a structured silicate salt can act as a charge controlling agent. JP'295 can not provide this teaching as such reference implicitly states that the silicate salt does not act as a charge controlling agent by the mere fact that JP reference discloses that the charge control agent is a quaternary ammonium salt compound, and no other.

To the best of Applicants' knowledge, there is no requirement that in a method claim there must be a manipulative step that is different from the prior art for such method to be patentable over the prior art. Specifically, the method claimed herein is clearly not obvious in view of the prior art as the prior art has not recognized nor has it disclosed, taught, or suggested that a structured silicate salt can be used as charge control agent. Furthermore, none of the references even

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intimate that an extender can be used for controlling the charge. Respectfully stated, using the Office's language, the "manipulative" difference as compared to the prior art, is the method claimed herein uses a structured silicate salt as an effective charge control agent.

For at least this reason, it is respectfully contended that the cited prior art does not make obvious Applicants' claimed invention.

On page 13 and 14 of the Office Action, the Office asserts that the comparative test data presented in the previously submitted § 132 declaration is "insufficient to show that the claimed invention provides unexpected results over the prior art because the declaration has not been compared to the closest prior art." Applicants respectfully disagree.

To the best of Applicants' knowledge, the commercially available product "TP-415" is di (fatty alkyl) dimethyl ammonium molybdate according to formula (1) in JP '295. The fact that the comparative test toner does not show a charge of 24 $\mu\text{C/g}$ (cf. JP'295, Table 2, Ex. 4) is due to the fact that JP'295 has used a different carrier. It is Applicants' respectful belief that it is known to a skilled artisan that the absolute value of the charge in a triboelectric toner depends on the tribo partners, i.e., the resin, the carrier and the charge control agent. The behavior of a charge control agent can only be determined if the other two partners (carrier and resin) are identical. As Applicants do not have available the same carrier and resins used in the JP'295 reference, Applicants used their own standard carrier and resin. Neither JP'295 nor the present invention is limited to a particular carrier resin system so it is proper to use any carrier and resin as long as the comparison is made in the same system. Therefore, courteously stated, Applicants are of the position that the results in the proffered declaration are an appropriate comparison to JP'295 and clearly demonstrate unexpected results.

For at least the above reasons, it is respectfully contended that Applicants' claimed invention, is not made obvious by any combination of JP'295 in combination

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with US 3,925,278, US 4,922,262 and US 5,385,766. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

Claims 1, 7, 8, 23 and 24 stand rejected under 35 USC § 103(a) as being unpatentable over Canadian Patent 2,244,367. This rejection is respectfully overcome.

The Office advances on page 17 of the Office Action certain polymeric species which it alleges would meet the limitation of a "low molecular, nonpolymeric organic cation." In independent claims 1 and 23, the subject matter of now cancelled claim 5 has been inserted. In addition, the repeat units on the species so named in page 17 of the Office Action have been excised from the claims. In view thereof, it is respectfully contended that the n,m-ionenes falls outside the scope of the amended claims and, therefore, CA'367 can not make Applicants invention obvious.

For all the forgoing reasons, it is respectfully contended that the 35 USC § 103 rejections has been either traversed or overcome. In consequence, Applicants courteously seek reconsideration and withdrawal of the rejections.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However, if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

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In view of the forgoing amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, she is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,



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